

Office Action Summary	Application No.		Applicant(s)	
	10/587,672		ERHARD HOFFMANN	
	Examiner		Art Unit	
	ISIAKA O. AKANBI		2886	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-10 and 13-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-10 and 13-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>May 20, 2009</u> . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Amendment

The amendment filed on 26 January 2009 has been entered into this application. Claims 7, 11 and 12 are cancelled. Claims 13-15 have been added.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8-10, 13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Miyahara (5,055,666).

Regarding claims 1, 13 and 15, Miyahara discloses a device for positioning markings comprising:

having a first equipment unit (**fig. 1: 10**), having means (**fig. 1: 13**) for disposing the first equipment unit (**fig. 1: 10**) at a predeterminable first position (i.e. location where b1 originated from) of a reference face, and

having optical signal means (**fig. 1: 11, b1**) for generating directional information (**fig. 1: s_x and s_y**), characterized in that the device has a second equipment unit (**fig. 1: 12, 20, 21 and 22**), which is positionable relative to the first equipment unit (**fig. 1: 10**) and which has means (**fig. 1: 11, b1**), which make it possible to ascertain the spacing of the second equipment unit (**fig. 1: 12, 20, 21 and 22**) from the first equipment unit (**fig.**

Art Unit: 2886

1: 10) in the direction (**fig. 1: s_x and s_y**) predetermined by the first equipment unit (**fig. 1: 10**)(**col. 2, lines 19-40**)(**col. 2, lines 63-col. 4, line 18**).

Miyahara also discloses a device that is automatic (**col. 1, lines 8-15**)(**col. 1, lines 56-62**) which is characterized by first equipment unit (**fig. 1: 10**) that has means (**fig. 1: 14, 30**) which make it possible to level the optical signal means (**fig. 1: 11, b1**), for generating directional information (**ΔL , $l\theta_h$, $l\theta_v$, s_x and s_y**) relative to the reference face (**col. 3, lines 3-col. 4, 18**), and thus meet the limitation a device which is characterized in that the optical signal means are self-leveling.

As to claim 2, Miyahara also discloses the limitation wherein the spacing determining means (**fig. 1: 11, b1, 21, 22, 12**) include an optical measuring system (**col. 3, lines 3-col. 4, 18**).

As to claim 3, Miyahara further discloses the limitation wherein the optical measuring system for determining spacing (fig. 1: L_m) includes optical signal means (**fig. 1: 11, b1, 21, 22, 12**) of the first equipment unit (**fig. 1: 10**).

As to claim 4, Miyahara also discloses the limitation wherein the optical measuring system for determining spacing that includes at least one light-sensitive sensor (**fig. 1: 12, 21, 22**).

As to claim 5, Miyahara further discloses optical signal means (**fig. 1: 10**) include at least one laser (**fig. 1: 11**).

As to claim 6, Miyahara also discloses the limitation wherein the first equipment unit (**fig. 1: 10**) that has means (**fig. 1: 14, 30**) which make it possible to level the optical

Art Unit: 2886

signal means (**fig. 1: 11, b1**), for generating directional information (**ΔL , l0h, l0v, s_x and s_y**) relative to the reference face (**col. 3, lines 3-col. 4, 18**).

As to claims 8 and 9, Miyahara also discloses a device which is characterized by spacing determining means (**fig. 1: 16, 20, 21, 22**) that include a mechanical measuring system and includes a travel pickup connected to the second equipment unit (**col. 4, lines 3-68**).

As to claim 12, Miyahara also discloses a device which is characterized by the second equipment unit (**fig. 1: 20**) has marking means (**fig. 1: 23**), which make it possible to mark a second position on the reference face which corresponds to the ascertained spacing from the predeterminable first position in the direction predetermined by the first equipment unit (**fig. 1: 10**)(**col. 3, lines 42-col. 4, line 2**).

Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Wiklund (5,229,828)

As to claim 14, Wiklund discloses a device for positioning markings comprising:
having a first equipment unit (**fig. 2: 21**), having means (**fig. 2: 22**) for disposing the first equipment unit (**fig. 2: 21**) at a predeterminable first position (i.e. location where originated from) of a reference face, and

having optical signal means (**fig. 2: see arrow from A, 24**) for generating directional information (**col. 4, lines 27-31**),

a second equipment unit (**fig. 2: 23/26**), which is positionable relative to the first equipment unit (**fig. 2: 21**) and which has means (**i.e. distance meter**), which make it possible to ascertain the spacing of the second equipment unit (**fig. 2: 23/26**) from the

Art Unit: 2886

first equipment unit **(fig. 2: 21)** in the direction predetermined by the first equipment unit **(fig. 2: 21) (col. 4, lines 18-41)**.

wherein the second equipment unit **(fig. 2: 23/26)** has marking means **(fig. 2: arrow pointing to positions on the car surface)**, which make it possible to mark a second position on the reference face **(i.e. fig. 2: top of the car surface)** which corresponds to the ascertained spacing from the predeterminable first position in the direction predetermined by the first equipment unit **(fig. 2: 21)(col. 4, lines 18-41)(col. 5, lines 3-24 and lines 59-66)**

For the purpose of clarity, Wiklund disclose measuring positions which inherently includes first, second and third positions. The first being the originated point/mark which is considered predetermined by the first equipment unit.

Response to Arguments

Applicant's arguments/remarks, see pages 10-13, filed on 26 January 2009, with respect to the rejection(s) of claim(s) 1-6 and 8-10 under 35 U.S.C. 102(b) have been fully considered but are not persuasive.

Applicant's arguments:

a) Miyahara does not have any means for producing marking on a predetermined location, in particular on the position of the second equipment unit which is positionable relative to the first equipment unit.

b) Miyahara does not disclose such a self-leveling in the gravitational field of the earth; and there is nothing to suggest or make possible to provide self-leveling.

Examiner's response:

Art Unit: 2886

With respect to arguments (a), it is respectfully pointed out to applicant that this argument is not persuasive because claim 1 of the instant application lacks the limitation such as “means for producing marking on a predetermined location, in particular on the position of the second equipment unit which is positionable relative to the first equipment unit”.

With respect to argument (b), it is respectfully pointed out to applicant that this argument is not persuasive as Miyahara clearly discloses in **(col. 1, lines 8-15)(col. 1, lines 56-62)** a device that is automatic (automatic= acting or operating in a manner essentially independent of external influence or control or Self-regulating (i.e. self leveling)). Additionally, it has been held that the absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus/device because the limitations at issue were found to be inherent in the prior art reference. In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971).

Finally, with respect to new claims 13-15, upon consideration, a rejection is made as detailed above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isiaka Akanbi whose telephone number is (571) 272-8658. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tarifur R. Chowdhury can be reached on (571) 272-2287. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/587,672
Art Unit: 2886

Page 8

/Isiaka Akanbi/

May 21, 2009

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Supervisory Patent Examiner, Art Unit 2886